

### REMARKS

The present application includes pending claims 1-3, 5-10, 12-15, and 17-20, all of which have been rejected. By this Amendment, claims 1, 2, 5-7, 9, 14, and 17-19 have been amended. It is respectfully submitted that the pending claims define allowable subject matter.

Claims 2, 5, 6, 7, 9, 14, 17, 18, and 19 were objected to because of informalities. The Applicants note that the “transitional phrase ‘consisting of’ excludes any element, step, or ingredient not specified in the claim.” *See* MPEP at 2111.03. The Applicants also note that the limitation “consisting of **at least one** of foam or rubber,” means foam (only foam, but still “at least one of foam or rubber”), rubber (only rubber, but still “at least one of foam or rubber”), or a combination of foam and rubber (which is still “**at least one** of foam or rubber”, because it includes both). The Applicants have amended these claims to conform to the suggestions made by the Examiner. As such, the Applicants respectfully request reconsideration of these claim objections.

Claims 1, 2, 3, 8, 9, 14, and 15 stand rejected under 35 U.S.C. 102(e) as being anticipated by United States Patent No. 6,441,614 (“Edelstein”). Claims 5-7, 9, 10, 12, and 17-19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Edelstein in view of United States Patent No. 4,594,781 (“Hirata”). Claim 20 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Edelstein in view of WO/01/25808 (“Feenan”). The Applicants respectfully traverse these rejections at least for the reasons discussed below, and previously during prosecution.

**I. Edelstein Does Not Anticipate The Claims Of The Present Application**

The Applicants first turn to the rejection of claims 1, 2, 3, 8, 9, 14, and 15 as being anticipated by Edelstein. Edelstein relates to a gradient coil assembly with an “annular space” between inner and outer gradient coil windings “filled with a filler material and, more particularly, to a concrete filler material comprising cement and a selected aggregate material.” Edelstein at column 1, lines 6-13.

Edelstein discloses a system in which a “concrete material, preferably a conglomerate of Portland cement and one or more selected aggregates, affords more effective suppression of vibration and noise.” *Id.* at column 3, lines 9-13. “Alternatively, a concrete cylinder with a hollow annulus, i.e., a cylindrical concrete sleeve” may be used. *Id.* at column 3, lines 18-25.

Edelstein, however, does teach, nor suggest, a “damping layer comprising at least one separate viscoelastic layer consisting of at least one of foam or rubber,” as recited in claim 1, as amended. While Edelstein discloses concrete layers, and even layers of material that are a mixture of concrete and other materials, Edelstein does not teach separate layers composed of foam and/or rubber.

Edelstein discloses a layer of concrete. *See id.* at column 4, lines 62-64 (“As shown in FIG. 3, concrete 26 is then poured into cylindrical space 13 from a nozzle 28, filling the space completely.”). Edelstein also discloses a hollow concrete cylinder. *See id.* at column 5, lines 42-45 (“A concrete cylinder 36, of a hollow cylindrical, or annular, construction and of appropriate inner and outer diameters, is disposed coaxially into cylindrical space 13...”).

Additionally, Edelstein discloses that various materials may be added to the concrete, thereby forming a single concrete filler having additional materials mixed throughout.

The concrete filler can be made in many sizes and forms, and also of many different compositions, to optimize its properties as a filler for the present purposes. Generally, concrete (i.e., “conventional” or “standard” concrete) consists of portland cement and an aggregate. The aggregate may comprise a selected one, or combination, of materials having lower density than portland cement, such as expanded shale, fly ash and pumice that reduce the weight, but have minimal adverse impact on the strength and stiffness of the concrete, compared to normal (i.e., higher density) concrete. Also, foam **can be introduced into** the concrete to make it lighter in weight. Fibers, such as glass, fiberglass, carbon fiber and plastic fibers, **can be included** to increase tensile strength, which is important since concrete cylinders 36 employed in the second and third embodiments of the invention have relatively thin annular walls compared, for example, to the annular wall thickness of poured concrete cylinder 26 in the first embodiment of FIGS. 1-4.... One preferred embodiment, with beneficial results was obtained **using a concrete made of cement with pumice aggregate and a water-latex solution.**

*Id.* at column 7, lines 28-52 (emphasis added). As clearly shown above, Edelstein discloses a concrete layer that may be formed **as a mixture of concrete and other materials, such as foam or a water-latex solution.** As such, Edelstein discloses a layer that includes concrete and other materials throughout. Edelstein, however, does not teach, nor suggest, a “separate viscoelastic layer consisting of at least one of foam or rubber.” Instead, Edelstein’s “filler” includes concrete and may include additional materials, as well. That is, Edelstein does not teach, nor suggest, a “damping layer comprising at least one separate **viscoelastic layer consisting of at least one of**

**foam or rubber.”** Thus, at least for this reason, the Applicants respectfully submit that Edelstein does not anticipate or render unpatentable claims 1, 9, 14 , or the claims that depend therefrom.

**II. The Combination Of Edelstein And Hirata Or Feenan Does Not Render The Claims Of The Present Application Unpatentable**

The Applicants now turn to the rejection of claims 5-7, 9, 10, 12, and 17-19 under 35 U.S.C. 103(a) as being unpatentable over Edelstein in view of Hirata. Further, claim 20 was rejected under 35 U.S.C. 103(a) as being unpatentable over Edelstein in view of Feenan.

A proposed combination of Edelstein with either Hirata or Feenan is improper. 35 U.S.C. 103(c) states the following:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The present application was filed on August 18, 2003. Edelstein qualifies as prior art with respect to the present application only under 35 U.S.C. 102(e).

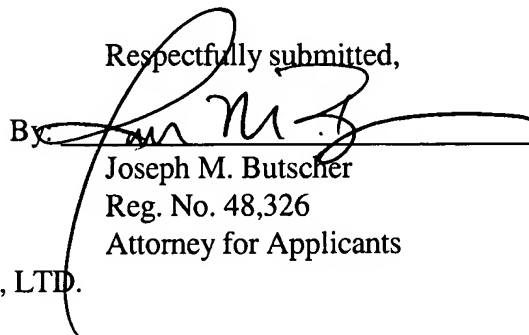
Edelstein and the claimed invention as described in the present application were entirely or wholly owned by the same entity at the time the claimed invention was made. Thus, the Applicants respectfully submit that Edelstein cannot be used in a 103(a) rejection against the claims of the present application. At least for this reason, the Applicants respectfully submit that claims 5-7, 9, 10, 12, and 17-20 should be in condition for allowance.

Appl. No. 10/642,846  
Amendment Under 37 C.F.R. § 1.116  
July 7, 2005

### III. Conclusion

The Applicants respectfully submit that the claims of the present application should be in condition for allowance at least for the reasons discussed above. The Applicants request reconsideration of the application and look forward to working with the Examiner to resolve any remaining issues in the application. If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited to contact the Applicants. The Commissioner is authorized to charge any necessary fees or credit any overpayment to Applicants' Deposit Account 07-0845.

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